



Patent
Attorney's Docket No. 032796-014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)

John P. CARULLI *et al.*)

Application No.: 09/543,771)

Filed: April 5, 2000)

For: HIGH BONE MASS GENE)
OF 11q13.3)

Group Art Unit: 1633

Examiner: Sumesh Kaushal, Ph.D.

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RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In complete response to the Restriction Requirement set forth in the Official Communication mailed on June 20, 2001 (Paper No. 11), Applicants hereby elect with traverse the claims of Group I (claims 1 and 14-23), which are drawn to an isolated amino acid sequence of SEQ ID NO: 4 (claim 1), a method of altering bone development by administering said amino acid sequence (claims 14-17), and a method for treating osteoporosis by administering said amino acid sequence (claims 18-23).

Applicants traverse the election for at least the following reasons. M.P.E.P. § 803 states that an application may be properly restricted to one or more claimed inventions only if (1) the inventions are independent or distinct as claimed, and (2) there is a serious burden on the Examiner if the restriction is not required. Thus, even if appropriate reasons exist for requiring restriction, such a restriction should not be made unless there is an undue burden on the Examiner to examine all of the claims in a single application.

Although the Examiner has alleged different classifications for the inventions of Group I (claims 1 and 14-23), Group II (claims 2, 3, and 10-13), Group III (claims 4-9), and Group IV (claims 24 and 25), it would seem that a search and examination involved for the four groups of the invention would substantially overlap. For example, the elected claims of Group I (claims 1 and 14-23), which are drawn to an isolated amino acid sequence (claim 1), a method of altering bone development by administering said amino acid sequence (claims 14-17), and a method for treating osteoporosis by administering said amino acid sequence (claims 18-23) involve utilizing the amino acid sequence of SEQ ID NO: 4. The non-elected invention of Group II (claims 2, 3, and 10-13) is drawn to a method of identifying a molecule that binds to/immobilizes an HBM protein (i.e., the amino sequence of SEQ ID NO: 4). The non-elected invention of Group III (claims 4-9) is drawn to a method for identifying a protein involved in bone modulation by identifying a protein (i.e., HBM protein) from a host comprising the HBM gene. Each invention from these groups involves the HBM protein (i.e., SEQ ID NO: 4). As overlapping subject matter between the elected and non-elected inventions exists, so too exists an apparent overlap in search and examination. Accordingly, a serious burden would not be imposed on the Examiner to examine all the claims of these groups in a single application. Thus, the restriction is improper and should appropriately be withdrawn.

Thus, for at least all of the reasons set forth above, withdrawal of the restriction requirement is requested and believed to be in order. Further and favorable consideration of all the claims of record on the merits is respectfully requested.

Applicants note for the record that in a conversation between Jay Williams and the Examiner on July 31 and August 1, 2001, the Examiner indicated that the "Attachment for PTO-948 (Rev. 03/01, or earlier)" was superfluous. No PTO-948 form or objections to the figures currently stand in the instant Application.

In the event that there are any questions relating to this Reply to Restriction Requirement, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 

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Date: August 13, 2001

☐ An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADDT'L FEE
Total Claims	25	MINUS 25 =	0	\$18.00 (103) =	0.00
Independent Claims	8	MINUS 8 =	0	\$80.00 (102) =	0.00
If Amendment adds multiple dependent claims, add \$270.00 (104)					
Total Amendment Fee					0.00
If small entity status is claimed, subtract 50% of Total Amendment Fee					
TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT					0.00

☐ A claim fee in the amount of \$_____ is enclosed.

☐ Charge \$_____ to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 

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